

### REMARKS

This Response is submitted in reply to the Office Action dated July 30, 2008. Applicant has amended Claims 1, 4, 10, 18, 21, 29, 37 to 38, 40, 48, 56 to 58, 60 to 62, 66, and 67. Claims 5, 13, 22, 32, 41, and 52 stand canceled. No new matter has been added by these amendments. Please charge Deposit Account No. 02-1818 for all payments due in connection with this Response.

The Office Action rejected Claims 1 to 4, 6 to 12, 14 to 21, 23 to 31, 33 to 40, 42 to 51, and 53 to 67 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2003/0036419 to Baerlocher et al. ("Baerlocher"). Applicant disagrees with and traverses this rejection.

Baerlocher discloses a gaming device which has award modification options for player selectable awards. The gaming device randomly generates a plurality of positions or digits of an award and enables the player to pick which position or digit receives a first randomly generated number, which digit receives a second randomly generated number, etc., until each of the positions have a number, whereby the gaming device determines the player's ultimate award based on the order of the number in the positions. In one version, the gaming device enables the player to decide whether to keep the currently generated award or risk the award and let the award modification take place. In another version, the gaming device automatically provides the award modification option to the player. In another version, the gaming device randomly generates one of the modification methods when the player decides to modify rather than keep a generated award. The modification methods include, among others: scrambling or rearranging the digits of an original award, completely regenerating the award, adding a digit to the award, subtracting a digit from the award and multiplying the award.

Amended independent Claim 1 is directed to a gaming device including, amongst other elements, a plurality of awards, wherein each of the awards has an award value, a plurality of the award values have a same number of digits, and each of the awards is statically associated with one of the offer components for a play of a game and a mechanical wheel including a plurality of sections, wherein each section is associated

with one of a plurality of different displayed component number modifiers, and each component number modifier has a displayed value. The gaming device of amended independent Claim 1 also includes a processor programmed to operate with the display device and the mechanical wheel, for the play of the game, to determine and display an offer based on the award values of all of the awards associated with the activated offer components, wherein the determined offer includes a plurality of activated offer components associated with the awards having award values with the same number of digits.

Applicant submits that Baerlocher does not anticipate or render obvious a processor programmed to operate with the display device and the mechanical wheel, for the play of the game, to determine and display an offer based on the award values of all of the awards associated with the activated offer components, wherein the determined offer includes a plurality of activated offer components associated with the awards having award values with the same number of digits.

Paragraph 10, lines 4 to 12 of Baerlocher disclose:

[m]ore specifically, the present invention provides a processor controlled gaming device that randomly generates a plurality of positions or digits of an award and enables the player to pick which position or digit receives a first randomly generated number, which digit receives a second randomly generated number, etc., until each of the positions have a number, whereby the gaming device determines the player's ultimate award based on the order of the number in the positions. (emphasis added)

Page 2 of the Office Action stated:

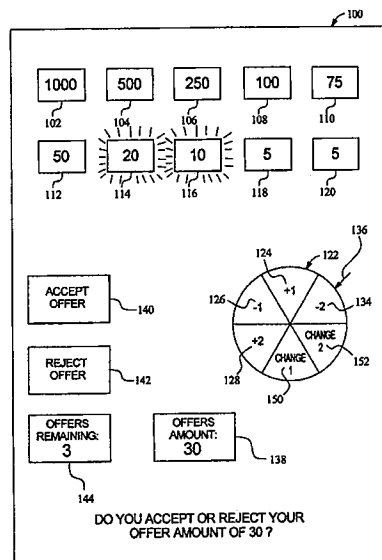
[a] player determines the position for each masked number in an offer component with respect to the final offer thus creating and displaying an award based on all of the selected award values. (emphasis added)

It appears that the Office Action is interpreting the "selected award values" as the "number in the positions" of Baerlocher. Applicant submits that under this interpretation no two interpreted "award values" of Baerlocher have the same number of digits. For example, Fig. 9 of Baerlocher illustrates an award of 614. Applicant submits that this award appears to include a 6 in the hundreds position (i.e., 600 has 3 digits), a 1 in the tens position (i.e., 10 has 2 digits), and a 4 in the ones position (i.e., 4 has 1 digit),

resulting in an award of 614. In this example, 600, 10, and 4 are the “selected award values”, and the award of 614 is “based on all of the selected award values” (i.e.,  $600+10+4=614$ ). On the other hand, the gaming device of amended independent Claim 1 is directed to, amongst other elements, a processor programmed to operate with the display device and the mechanical wheel, for the play of the game, to determine and display an offer based on the award values of all of the awards associated with the activated offer components, wherein the determined offer includes a plurality of activated offer components associated with the awards having award values with the same number of digits. For example, as seen in Fig. 4A of the present application (reproduced below), the gaming system determines and displays an offer amount of 30 in offer amount display 138. In this example, the determined offer includes activated offer components 114 and 116, which display award values of 20 and 10 respectively, and the award values of 20 and 10 each have the same number of digits (i.e., the award value 20 has 2 digits, and the award value 10 has 2 digits). Applicant submits that it would not have been obvious to one of ordinary skill in the art to modify Baerlocher to result in such a gaming device without reasonably being construed as improper hindsight reconstruction.

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FIG. 4A



Page 2 of the Office Action stated:

[t]he game instructs the player to use the digits to create an award from a range of possible awards or offers (fig. 3b). Therefore the game the digits are statically associated with an offer component, the box that outlines the value...An offer component is activated and displayed when a player selects it (fig. 3D, 120). (emphasis added)

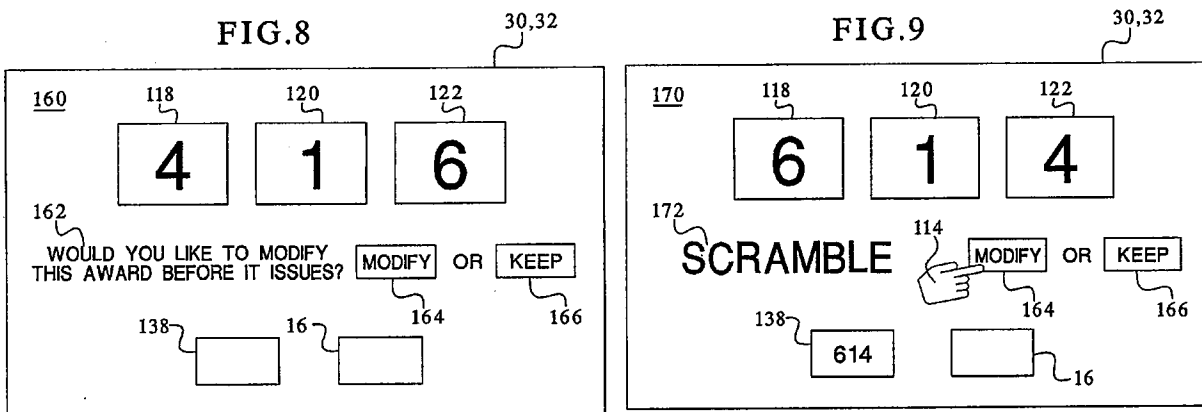
Applicant respectfully disagrees and reiterates the arguments conveyed in the response to the Office Action of 3/26/08 that Baerlocher does not to anticipate or render obvious that each of the awards is statically associated with one of the offer components for a play of a game.

Additionally, Applicant submits that the Examiner appears to interpret the digits in the award of Baerlocher (element 120 of Fig. 8 and Fig. 9 of Baerlocher) as the offer components of amended independent Claim 1. Baerlocher illustrates, in at least Figs. 8 and 9, each digit in the award being associated with different values during a play of the game. Fig. 8 and Fig. 9 of Baerlocher are displayed below.

In relation to Fig. 9 and the description thereof, Baerlocher discloses:

[r]eferring now to FIG. 9, a screen 170 displays the award rearrangement or scramble modification method of the present invention, wherein one of the display devices 30 or 32 displays the original award of 416 in the positions or digits 118 through 122 (Baerlocher, paragraph [0111] lines 1 to 3). (emphasis added)

[i]n the screen 170 of Fig. 9, when the player 114 selects the modify input 164, the game displays a suitable symbols or message 172 indicating that the scramble modification method has been generated. The game thereafter scrambles or rearranges the original award and forms a new award of 614 (Baerlocher, paragraph [0114] lines 1 to 6). (emphasis added)



Applicant submits that, in this example, Baerlocher illustrates digits in the award (i.e., elements 118 and 122, interpreted by the Office Action as offer components) that are associated with a plurality of different values during a play of the game. That is, at least one of the digits in the award of Baerlocher displays at least 2 different values during a play of the game. Specifically, element 118 and element 122 of Fig. 8 and Fig. 9 of Baerlocher appear to display both a 4 and a 6 for a play of the game. Therefore, Applicant submits that Baerlocher does not anticipate or render obvious each of the awards is statically associated with one of the offer components for a play of a game. Rather, it appears that at least one of the positions or digits in the award of Baerlocher are configured to display a plurality of different award values during a play of a game. On the other hand, amended independent Claim 1 is directed to a gaming device including, amongst other elements, a plurality of awards, wherein each of the awards is statically associated with one of the offer components for a play of a game. That is, for the gaming device of amended independent Claim 1, each offer component is associated with the same award value for a play of the game (i.e., the values displayed in each offer component do not change for a play of the game). Moreover, Applicant submits that it would not have been obvious to one of ordinary skill in the art to modify Baerlocher to result in such a gaming device without reasonably being construed as improper hindsight reconstruction.

Page 3 of the Office Action stated:

[a]dditionally the displaying of all possible modifiers at once to a player is also viewed as mere design choice since in both games the player has no say in which modifier will be used therefore each game takes a different approach on 'building suspense' as unknown (prior art) or identified (applicant) consequences.

Applicant disagrees and reiterates the arguments conveyed in the response to the Office Action of 6/3/08 that each component number modifier has a displayed value is substantially more than a simple design choice and that it is improper for the Office Action to contend that prior art references do not disclose certain claimed elements and then simply state that these claimed elements are a simple design variation. Without providing any reference which discloses these claimed elements, any conclusions that such claimed elements are a simple design choice is impermissible. As stated in *In re Chu*, the finding of *In re Gal* is that "obvious design choice" is precluded where the claimed structure and the function it performs are different from the prior art. *In re Chu*, 66 F.3d 292 (Fed. Cir. 1995); *In re Gal*, 980 F.2d 717 (Fed. Cir. 1992)..

Applicant also reiterates the argument conveyed in the response to the Office Action of 6/3/08 that Baerlocher does not anticipate or render obvious a plurality of different displayed component number modifiers, wherein each component number modifier has a displayed value.

Additionally, Applicant has amended certain the claims to include a mechanical wheel including a plurality of sections, wherein each section is associated with one of a plurality of different component number modifiers, and each component number modifier has a displayed value. Accordingly, Applicant submits that Baerlocher does not anticipate or render obvious a mechanical wheel including a plurality of sections, wherein each section is associated with one of a plurality of different component number modifiers, and each component number modifier has a displayed value. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Baerlocher to result in such a gaming device without reasonably being construed as improper hindsight reconstruction.

For at least these reasons, amended independent Claim 1 is patentably distinguished over Baerlocher and is in condition for allowance.

Claims 2 to 4 and 6 to 9 depend directly or indirectly from amended Claim 1 and are allowable for similar reasons, and because of the additional features recited in these claims.

Amended independent Claims 10, 18, 29, 37, 48, 56, 57, 58, 62, 66, and 67 each include certain similar elements to amended independent Claim 1. For reasons similar to those discussed above with respect to amended independent Claim 1, amended independent Claims 10, 18, 29, 37, 48, 56, 57, 58, 62, 66, and 67 (and dependent Claims 11, 12, 14 to 17, 19 to 21 23 to 28, 30, 31, 33 to 36, 38 to 40 42 to 47, 49 to 51 53 to 55, 59 to 61, and 63 to 65) are each patentably distinguished over Baerlocher and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance, which is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY 

Adam H. Masia  
Reg. No. 35,602  
Customer No. 29159  
(312) 807-4284

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